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10/805,103	03/19/2004	David del Val	MS1-578USC1	8504
22801	7590	03/03/2008	EXAMINER	
LEE & HAYES PLLC			HARRELL, ROBERT B	
421 W RIVERSIDE AVENUE SUITE 500				
SPOKANE, WA 99201				
			ART UNIT	PAPER NUMBER
			2142	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,103	Applicant(s) DEL VAL ET AL.	
	Examiner Robert B. Harrell	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004 et seq.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20040319</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

Art Unit: 2142

1. Claims 29-56 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The drawings submitted on 22 June 2004 do not comply with 37 C.F.R. 1.121(d) in that they are not properly identified in the top margin as "Replacement Sheet", "New Sheet", or "Annotated Sheet". Thus, the drawings must be resubmitted with the correct labels in compliance with 37 C.F.R. 1.121(d).
4. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 29-56 are rejected under 35 U.S.C. 101 because the claimed invention, in light of the specification, encompasses non-statutory subject matter since such reads on (encompass) software or program per se' (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106 (New EXAMINATION GUIDELINES FOR COMPUTER-RELATED INVENTIONS). Even though drafted as "A method", each of the recited elements encompass their software or program per se' equivalent and thus the whole of the method encompasses software or program per se'; unlike "A method executing on a hardware". As for the apparatus claims, such encompass only software or program per se' equivalents; unlike "A hardware apparatus". As for the computer-readable medium, such encompasses a carrier wave or transmission link (carrier waves store data for the duration of transmission over a period of time and is thus storage); unlike a "hardware computer readable storage medium."

7. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2142

8. **Claims 29-56 are rejected under 35 U.S.C 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:

a) "the network"--claim 29 (lines 5-6), claim 36 (line 7), and claim 43 (line 8) [* note lines 1-2, of claim 29 "network", and line 4 "network" *];

9. As to 8 (a) above, these are but a few examples of numerous cases where clear antecedent basis are lacking and not an exhausting recital. Any other term(s) or phrase(s) over looked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent basis also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introductions of a term, or changes in tense, results in a lack of clear antecedent basis for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent basis are lacking can be viewed as non-responsive. Nonetheless, should a response yield all claims allowable short *a few* cases where clear antecedent basis are lacking within the claims, a preemptive authorization to enter an examiner's amendment to the record to correct such would accelerate a notice of allowance over a final rejection. Such could be added at the end of an applicant's response with the following statement: "Examiner is hereby authorized, without the need of further contact by examiner, to enter an Examiner's Amendment to correct any cases where antecedent basis are lacking." if the applicant so elects. This does not diminish the applicant's requirement to correct all such cases not so listed in the example few given above nor prohibit any amendments after a notice of allowance by the applicant.

10. The scope of meaning of the claim language is not clear since it cannot be clearly ascertained if the claims encompass only hardware, or software, or a combination since there is no clear recital of actual hardware.

11. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), In re Berg 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998), 195 F.3d 1322, 1326, 52 USPQ2d (Fed. Cir. 1999), Eli Lilly CAFC on petition for rehearing En Banc (58 USPQ2d 1869).

12. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non statutory based double

Art Unit: 2142

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

13. **Claims 29-56 are rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over claims 1-28 of United States Patent 6,763,392. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims contains every element of the application of the instant application and as such anticipates claims 29-56 of the instant application. That is, this application encompasses the claims of United States Patent 6,763,392.

14. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

16. **Claims 29-56 are rejected under 35 U.S.C. 102 (e)** as being anticipated by Chou (United States Patent Number: 6,637,031 B1).

Art Unit: 2142

17. Per claim 29, Chou taught a method for streaming media (e.g., see Abstract) through at least a portion of a network (e.g., see figure 2 (206)), the method comprising:

- a) transferring an initial portion of a stream of data from a first device (e.g., see figure 2 (204) to at least a second device (e.g., see figure 2 (208)) through an interconnecting network (e.g., see figure 2 (206), Abstract and col. 14 (line 25-35));
- b) establishing a desired quality of service path (i.e., bit rate, and/or bit rate path, via the network) within at least a portion of the network from the first device to the second device (e.g., see Abstract and col. 14 (line 25-35)); and
- c) transferring a subsequent portion of the stream of data over the established quality of service path from the first device to the second device (e.g., see Abstract and col. 14 (line 25-35)).

18. Per claim 30, claim 31, claim 32, claim 33, claim 34, and claim 35, the lower level quality of service first protocol bit rate initial stream of data, from the first device to the second device, was transmitted while establishing the higher quality of service second protocol bit rate (e.g., see Abstract "quality" and col. 14 (line 25-35)).

19. Since Chou encompassed the Internet (e.g., see first paragraph of the Chou's Background), RTSP and RSVP were anticipated methods of transmitting multimedia streaming data. Also, since Chou encompassed the packet switched Internet, some paths were slow and others fast, thus the higher bit rate could not transverse a slower path, in real time; and, thus, it was anticipated that the path selected, or reserved, must have accommodated the higher bit rates.

20. Per claims 36-56, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

21. *A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).*

Art Unit: 2142

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (571) 273-8300.

24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

A handwritten signature in black ink, appearing to read 'Robert B. Harrell', with a long horizontal line extending to the right.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142